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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,242	01/12/2001	Robert J. Davidson	10002343-1 (SEAG 77938)	2554

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EXAMINER	
SHELEHEDA, JAMES R	
ART UNIT	**PAPER NUMBER**
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03/10/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/760,242	DAVIDSON, ROBERT J.	
	Examiner	Art Unit	
	JAMES SHELEHEDA	2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 January 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,8-15,19,20,24-26,32 and 37-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,8-15,19,20,24-26,32 and 37-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/26/09 has been entered.

Response to Arguments

2. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-5, 8-15, 19, 20, 24-26, 32 and 37-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a

way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1, lines 5-7, recite "programming access instructions in a programmable controller without modifying the entertainment media previously stored in memory" which is not supported by the specification as originally filed.

While the specification discloses an optional controller for facilitating control of the *module* (page 6, lines 21-23) and storing access instructions in the *module* (page 5, lines 10-32), there is no specific support for the language of "programming access instructions in a programmable controller" or "programming access instructions…without modifying the entertainment media previously stored in memory", as recited in the claims. The specification is silent as to how and where the access instructions are stored within the module. There is no specific description of the controller being "programmable" and what functions are performed by the controller. Finally, there is no specific disclosure of what method is used to "encode" the access instructions within the module (see applicant's specification at page 5, lines 28-31) and whether or not the media programs are "modified".

Claim 9, lines 6-9, recite "a programmable controller in the enclosure configured for being programmed with access instructions without modifying the previously stored entertainment media in the memory" which is not supported by the specification as originally filed.

While the specification discloses an optional controller for facilitating control of the module (page 6, lines 21-23) and storing access instructions in the module (page 5, lines 10-32), there is no specific support for the language of "programming access instructions in a programmable controller" or "programming access instructions…without modifying the entertainment media previously stored in memory", as recited in the claims. The specification is silent as to how and where the access instructions are stored within the module. There is no specific description of the controller being "programmable" and what functions are performed by the controller. Finally, there is no specific disclosure of what method is used to "encode" the access instructions within the module (see applicant's specification at page 5, lines 28-31) and whether or not the media programs are "modified".

Claim 39, lines 2-3, recite "reprogramming the access instructions in the programmable controller without modifying the entertainment media previously stored in the memory" which is not supported by the specification as originally filed.

While the specification discloses an optional controller for facilitating control of the *module* (page 6, lines 21-23) and storing access instructions in the *module* (page 5, lines 10-32), there is no specific support for the language of "reprogramming access instructions in a programmable controller" or "reprogramming access instructions…without modifying the entertainment media previously stored in memory", as recited in the claims. The specification is silent as to how and where the access instructions are stored within the module. There is no specific description of the

controller being "programmable" and what functions are performed by the controller. Finally, there is no specific disclosure of what method is used to "encode" the access instructions within the module (see applicant's specification at page 5, lines 28-31) and whether or not the media programs are "modified".

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-5, 8, 19, 20, 24, 25, 32, 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung (6,628,963) (of record) in view of Kawakami et al. (Kawakami) (7,266,202).

As to claim 1, while Chung discloses a method of portably handling entertainment media (column 1, lines 5-12) comprising:

storing the entertainment media in a memory of a portable digital storage module (column 1, lines 37-40, column 2, line 56-column 3, line 20),

he fails to specifically disclose after the storing the entertainment media step is completed, programming access instructions in a programmable controller without modifying the entertainment media previously stored in the memory, the programmed access instructions defining a prescribed authorized usage of the stored entertainment media.

In an analogous art, Kawakami discloses a content delivery system (see Fig. 1) wherein digital content is downloaded onto a portable media player (Fig. 3; column 6, lines 32-55) and a programmable controller is programmed with access instructions corresponding to a predefined limit of authorized playings of the entertainment media are (Fig. 3; column 8, lines 11-23 and column 12, lines 50-55) without modifying the entertainment media previously stored in the memory (where the access instructions are separately stored; see Fig. 4, 114) for the typical benefit of ensuring that the rights of content owners are secured in a digital content distribution system (column 1, lines 7-67).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Chung's system to include after the storing the entertainment media step is completed, programming access instructions in a programmable controller without modifying the entertainment media previously stored in the memory, the programmed access instructions defining a prescribed authorized usage of the stored entertainment media, as taught in combination with Kawakami, for the typical benefit of ensuring that the rights of content owners are secured in a digital content distribution system.

As to claim 2, Chung and Kawakami disclose wherein the storing the entertainment media step further comprises transferring a copy of the entertainment media from a purchase center into the memory of the portable digital storage module (see Kawakami at column 6, lines 20-32 and column 16, lines 35-60).

As to claim 3, Chung and Kawakami disclose wherein the storing the entertainment media step further comprises downloading the entertainment media from a remotely located database (see Kawakami at column 6, lines 20-32 and column 16, lines 35-60).

As to claim 4, Chung and Kawakami disclose repeating the storing the entertainment media step to store two or more entertainment media into the memory of the portable digital storage module (downloading and storing a plurality of movie files; see Chung at column 1, lines 5-12, lines 37-40 and column 2, lines 55-62).

As to claim 5, Chung and Kawakami disclose wherein the retrieving step is characterized by the digital format player device including a personal movie player (portable multimedia player; see Chung at Figs. 1 and 2; column 1, lines 20-30).

As to claim 8, Chung and Kawakami disclose wherein the storing step is performed in a broadband frequency format (MPEG format; see Chung at column 2, line 35 - column 3, line 11).

As to claim 19, Chung and Kawakami disclose wherein the storing access instructions step is characterized by granting permission to playback the entertainment media a finite number of times (see Kawakami at column 8, lines 17-24).

As to claim 20, Chung and Kawakami disclose wherein the storing access instructions step is characterized by granting permission to playback the entertainment media within a finite period of time (see Kawakami at column 11, lines 19-28).

As to claim 24, Chung and Kawakami discloses wherein the storing step is characterized by the entertainment media comprising audio data (see Chung at column 1, lines 6-14).

As to claim 25, Chung and Kawakami disclose wherein the storing step is characterized by the entertainment media comprising video data (see Chung at column 1, lines 6-14).

As to claim 32, Chung and Kawakami disclose wherein the storing access instructions step is characterized by automatically deleting the entertainment media from the memory according to the prescribed authorized usage (see Kawakami at column 26, lines 1-20).

As to claim 37, Chung and Kawakami disclose retrieving the entertainment media from the memory of the portable digital storage module with a digital format player device in accordance with permission granted by the access instructions (see Kawakami at column 8, lines 11-23).

As to claim 39, Chung and Kawakami disclose after a request for usage of the stored entertainment media, reprogramming the access instructions in the programmable controller without modifying the entertainment media previously stored in the memory, thereby changing the prescribed authorized usage of the stored entertainment media in relation to the request for a usage of the stored entertainment media (see Kawakami at column 8, lines 18-24 and column 11, lines 19-28).

7. Claims 9, 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung in view of Katayama et al. (Katayama) (6,651,212) (of record) and Kawakami.

As to claim 9, while Chung discloses a portable storage module (column 2, lines 55-62 and column 1, lines 37-40) comprising:

a pocket size enclosure that is removably connectable to a digital format player device (flash memory or multimedia card; Fig. 3; column 2, lines 56-62) in a data transfer relationship (see Fig. 3; column 2, lines 50-60 and column 1, lines 34-40 and lines 56-62),

a memory in the enclosure for storing and retrieving sequential entertainment media (column 2, lines 50-62), he fails to specifically disclose a controller in the enclosure for executing instructions stored in the memory for granting the digital format player device access to selected data stored in the memory according to a predefined limit of authorized playing of the selected data.

In an analogous art, Katayama discloses wherein a removable flash memory device (Fig. 1; 101) comprising controller logic (102) for operating the storage device and communicating between the memory component (111-114) and the communications interface (105-106) (Fig. 1; column 10, lines 10-37), for the typical benefit of reducing the size and weight of the memory by integrating the controller and memory into a single chip (column 2, lines 17-23).

Additionally, in an analogous art, Kawakami discloses a content delivery system (see Fig. 1) wherein digital content is downloaded onto a portable media player (Fig. 3; column 6, lines 32-55) and a programmable controller is programmed with access instructions corresponding to a predefined limit of authorized playing of the entertainment media are (Fig. 3; column 8, lines 11-23 and column 12, lines 50-55) without modifying the entertainment media previously stored in the memory (where the access instructions are separately stored; see Fig. 4, 114) for the typical benefit of ensuring that the rights of content owners are secured in a digital content distribution system (column 1, lines 7-67).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Chung's system to include a controller in the enclosure for executing instructions stored in the memory, as taught in combination with Katayama, for the typical benefit of reducing the size and weight of the memory by integrating the controller and memory into a single chip.

Additionally, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Chung and Katayama's system to include after

the storing the entertainment media step is completed, programming access instructions in a programmable controller without modifying the entertainment media previously stored in the memory, the programmed access instructions defining a prescribed authorized usage of the stored entertainment media, and configured for enforcing the programmed access instructions in response to the digital storage module receiving a request to playback the stored entertainment media, as taught in combination with Kawakami, for the typical benefit of ensuring that the rights of content owners are secured in a digital content distribution system.

As to claim 10, Chung, Katayama and Kawakami disclose a communication interface (see Katayama at Fig. 1) subject to the programmable controller (Fig. 1; column 10, lines 13-37) in transferring data from the memory to the digital format player device (see Katayama at Fig. 1; column 10, lines 13-37).

As to claim 15, Chung, Katayama and Kawakami disclose wherein the memory is configured for subsequently storing data wherein different data was previously stored (see Chung at column 2, lines 56-62).

8. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung, Katayama and Kawakami as applied to claim 9 above, and further in view of Gibson.

As to claim 11, while Chung, Katayama and Kawakami disclose a memory, they fail to specifically disclose wherein the memory is characterized as an atomic resolution storage device comprising:

a field emitter fabricated by semiconductor micro fabrication techniques capable of generating an electron beam current; and

a storage medium in proximity to the field emitter and having a storage area in one of a plurality of states to represent the information stored in the storage area.

In an analogous art, Gibson discloses the use of an atomic resolution storage device (Figs. 1A-C; column 1, line 63-column 2, line 33) as opposed to conventional storage technologies (column 1, lines 14-21), the atomic resolution storage device comprising a field emitter fabricated by semiconductor micro-fabrication techniques capable of generating an electron beam current (see Gibson at column 2, line 65 - column 3, line 29), and a storage medium in proximity to the field emitter and having a storage area in one of a plurality of states to represent the information stored in the storage area (see Gibson at column 3, lines 1-5) for the typical benefit of providing ultra-high density storage with fast access times and high data rates (column 1, lines 52-62).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Chung, Katayama and Kawakami's system to include wherein the memory is characterized as an atomic resolution storage device comprising: a field emitter fabricated by semiconductor micro fabrication techniques capable of generating an electron beam current; and a storage medium in proximity to the field emitter and having a storage area in one of a plurality of states to represent the

information stored in the storage area, as taught in combination with Gibson, for the typical benefit of taking advantage of the benefits provided by an atomic resolution storage device, such as fast access times and high data rates combined with ultra-high density storage.

As to claim 12, Chung, Katayama, Kawakami and Gibson disclose an effect being generated when the electron beam current bombards the storage area, wherein the magnitude is dependent on the state of said storage, and wherein storage data is read by measuring the magnitude of the effect (see Gibson at column 5, line 64 - column 6, line 10).

As to claim 13, Chung, Katayama, Kawakami and Gibson disclose the atomic resolution storage module further comprising a plurality of storage areas on the storage medium, each storage area in one of a plurality of states to represent information stored in the storage area (see Gibson at column 5, line 64 – column 6, line 10), and a micro fabricated mover in the storage device for positioning various areas to be bombarded by the electron beam current (see Gibson at column 6, lines 2-10).

As to claim 14, Chung, Katayama, Kawakami and Gibson disclose the atomic resolution storage module further comprising a plurality of said field emitters (see Gibson at column 2, line 65 - column 3, line 5), with each emitter fabricated by semiconductor micro fabrication techniques capable of generating an electron beam

current (see Gibson at column 3, lines 5-20), with each emitter space apart, and with each emitter being responsible for a number of storage areas such that said emitters can function in parallel to increase the data rate of the storage device (see Gibson at column 3, line 57 - column 4, line 20).

9. Claims 26 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung and Kawakami as applied to claim 1 above, and further in view of Downs et al. (Downs) (6,226,618) (of record).

As to claim 26, while Chung and Kawakami disclose storing access instructions and a purchase price, they fail to specifically disclose wherein the programming access instructions steps is characterized by a predetermined association between a user-selected purchase price for the entertainment media and the corresponding authorized usage.

In an analogous art, Downs discloses a content delivery system (see Figs. 1A-D) wherein digital content is downloaded onto a portable media player (column 6, lines 35-48) which is encoded with access instructions corresponding to a predefined limit of authorized playing of the entertainment media (column 11, lines 30-55 and column 7, lines 41-55) wherein the access instructions are characterized by a predetermined association between a user-selected purchase price for the entertainment media and the corresponding authorized usage (usage tables; see Downs at columns 59 and 61) for the typical benefit of providing the user with more flexibility in accessing their desired content within the desired manner (see Downs at columns 59 and 61).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Chung and Kawakami's system to include wherein the programming access instructions steps is characterized by a predetermined association between a user-selected purchase price for the entertainment media and the corresponding authorized usage, as taught in combination with Downs, for the typical benefit of providing the user with more flexibility in accessing their desired content within the desired manner.

As to claim 38, Chung, Kawakami and Downs disclose the user selected purchase price being determined by a users input to a point of purchase system (see Downs at usage tables, column 59 and column 61), wherein the stored entertainment media resides in the memory of the digital storage module prior to the user's input (see Downs at column 78, lines 28-67).

Conclusion

10. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES SHELEHEDA whose telephone number is (571)272-7357. The examiner can normally be reached on Monday - Friday, 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Sheleheda/
Examiner, Art Unit 2424

JS